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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/699,901	11/03/2003	Martin Novil	03-0019/CPA	4385

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FREUDENBERG-NOK GENERAL PARTNERSHIP
INTELLECTUAL PROPERTY DEPT.
47690 EAST ANCHOR COURT
PLYMOUTH, MI 48170-2455

EXAMINER

PICKARD, ALISON K

ART UNIT	PAPER NUMBER
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3676

DATE MAILED: 03/08/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/699,901

Applicant(s)

NOVIL ET AL.

Examiner

Alison K. Pickard

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-58 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-58 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____.
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: ____.

DETAILED ACTION

Claim Rejections - 35 USC § 112

1. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

2. Claim 27 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claim 27, "said resilient sealing material" lacks antecedent basis.

Claim Rejections - 35 USC § 102

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

2. Claims 1, 4, 5, 9-11, 18-26, 28, 29, 31, 35, 36, 40, 41, 48-56, and 58 are rejected under 35 U.S.C. 102(b) as being anticipated by Miyaoh (5,988,651).

Miyaoh discloses an assembly comprising at least two carriers A10 (see col. 2, lines 48-52), each having a thickness and opening Hw. A flexible inner sealing portion A13 is disposed adjacent the opening and is offset from the rest of the carrier. A flexible outer stopper portion A11 (or A12) is spaced laterally from the opening and outward from the inner sealing portion. The stopper is less flexible than the inner seal portion, and thus limits compression of the inner portion. As seen best in Figure 2, the inner seal A13 is offset to a greater extent than the convex portion of the stopper A11. The carriers are steel. The gasket is capable of being used in the

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devices required by the claims (e.g. claims 18-26). Since Miyaoh discloses more than one carrier can be used, one of them could be considered a shim (e.g. for claim 31).

Claim Rejections - 35 USC § 103

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claims 2, 3, 6-8, 13-17, 30, 32-34, 37-39, and 43-47 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyaoh in view of Zerfass (6,343,795).

Miyaoh does not disclose a resilient material on portions of the carrier. Zerfass teaches a gasket assembly coated with a resilient sealing material. The material coats the carrier and fills the concave surface of beads/stoppers. Zerfass teaches that the coating provides micro-sealing of irregular surfaces and prevents excessive deformation of the beads. Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the coating taught by Zerfass to improve the assembly by providing micro-sealing and preventing excessive deformation of the beads/stoppers.

5. Claims 12 and 42 are rejected under 35 U.S.C. 103(a) as being unpatentable over Miyaoh.

Miyaoh does not disclose the carriers are made of a synthetic material. The selection of a known material based on its suitability for its intended use is not considered inventive. See *In re Leshin* 125 USPQ 416 (CCPA 1960). Therefore, it would have been obvious for one of ordinary

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skill in the art at the time the invention was made to make the carrier of a synthetic as a matter of choice in design.

6. Claims 1, 27, 31, 32, and 57 are rejected under 35 U.S.C. 103(a) as being unpatentable over Combet (6,371,489) in view of Miyaoh.

Combet discloses a gasket assembly comprising at least two carriers (or a carrier and shim) 2 and 3. The carriers each have an opening 4, flexible inner sealing portions (at 8 or bead next to it) around the openings, and resilient sealing material (at 13). Portions of the carriers are separated but joined by the sealing material (see Fig. 4). Combet does not disclose the outer stopper portion that is less flexible than the sealing portions. Miyaoh teaches a gasket assembly. Miyaoh teaches the use of a stopper portion A11 to prevent over compression of the sealing beads (i.e. sealing portions). Therefore, it would have been obvious for one of ordinary skill in the art at the time the invention was made to use the stoppers taught by Miyaoh to prevent over compression of the sealing portions.

Conclusion

7. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Alison K. Pickard whose telephone number is 703-305-0882. The examiner can normally be reached on M-F (10-7:30), with alternate Friday's off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Heather Shackelford can be reached on 703-308-2978. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Alison K. Pickard
Primary Examiner
Art Unit 3676



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